REMARKS

Claims 1-97 are pending in the instant application. In the Office Action mailed October 5, 2005, the Examiner rejects claims 1-3, 6, 7, 9-21, 44-46, 83-85, and 88-97. Claims 4, 5, 8, 22-43, 47-82, 86, and 87 are withdrawn pending allowance of a generic claim.

Based on the remarks made herein, Applicants respectfully request that the rejections be withdrawn and that the application be passed to allowance.

1. Remarks on the Office Action mailed on October 5, 2005: Rejection of Claims 1-3, 6, 7, 9-21, 44-46, 83-85, and 88-97 as Obvious

In the Office Action mailed October 5, 2005, the Examiner rejected claims 1-3, 6, 7, 9-21, 44-46, 83-85, and 88-97 as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,261,679 to Chen et al. (hereinafter "the Chen patent").

With respect to independent claims 1, 17, 44, and 83, the Examiner believes the Chen patent provides an absorbent composition comprising a superabsorbent material and a cooling compound.

Claim 1 is directed to an absorbent composition including a water-swellable, water-insoluble absorbent material; and a cooling compound, wherein the cooling compound has an endothermic effect, wherein the absorbent composition exhibits an absorbent capacity of at least 10 grams of 0.9 wt% NaCl saline per gram of the absorbent composition and a cooling effect of at least a 2°C reduction in temperature of at least a portion of the absorbent composition. Contrary to the Examiner's claim, the Chen patent does not disclose an absorbent composition including a cooling compound, wherein the cooling compound has an endothermic effect, wherein the absorbent composition exhibits an absorbent capacity of at least 10 grams of 0.9 wt% NaCl saline per gram of the absorbent composition and a cooling effect of at least a 2°C reduction in temperature of at least a portion of the absorbent composition. In fact, the Chen patent does not disclose a cooling compound, a cooling effect, or an endothermic effect in any respect.

Claim 17 is directed to an absorbent composition including a water-swellable, water-insoluble acidic absorbent material; and a cooling compound, wherein the cooling compound has an endothermic effect and is a basic compound capable of neutralizing the acidic absorbent material, wherein the absorbent composition exhibits an absorbent capacity of at least 10 grams of 0.9 wt% NaCl saline per gram of the absorbent composition and a cooling effect of at least a 2°C reduction in temperature of at least a portion of the absorbent composition. Contrary to the Examiner's claim, the Chen patent does

not disclose an absorbent composition including a cooling compound, wherein the cooling compound has an endothermic effect and is a basic compound capable of neutralizing the acidic absorbent material, wherein the absorbent composition exhibits an absorbent capacity of at least 10 grams of 0.9 wt% NaCl saline per gram of the absorbent composition and a cooling effect of at least a 2°C reduction in temperature of at least a portion of the absorbent composition. In fact, the Chen patent does not disclose a cooling compound, a cooling effect, or an endothermic effect in any respect.

Claim 44 is directed to a method for producing an absorbent composition capable of exhibiting a cooling effect, the method including selecting a water-swellable, water-insoluble absorbent material; selecting a cooling compound having an endothermic effect; and combining the absorbent material and the cooling compound to form the absorbent composition such that the absorbent composition exhibits an absorbent capacity of at least 10 grams of 0.9 wt% NaCl saline per gram of the absorbent composition and a cooling effect of at least a 2°C reduction in temperature of at least a portion of the absorbent composition. Contrary to the Examiner's claim, the Chen patent does not disclose selecting a cooling compound having an endothermic effect, nor does the Chen patent disclose combining the absorbent material and the cooling compound to form the absorbent composition such that the absorbent composition exhibits an absorbent capacity of at least 10 grams of 0.9 wt% NaCl saline per gram of the absorbent composition and a cooling effect of at least a 2°C reduction in temperature of at least a portion of the absorbent composition. In fact, the Chen patent does not disclose a cooling compound, a cooling effect, or an endothermic effect in any respect.

Claim 83 is directed to an absorbent composition including a superabsorbent material; and a sufficient amount of cooling compound such that the absorbent composition is adapted to provide a cooling effect in at least a portion of the composition while absorbing aqueous liquid. Contrary to the Examiner's claim, the Chen patent does not disclose a sufficient amount of cooling compound such that the absorbent composition is adapted to provide a cooling effect in at least a portion of the composition while absorbing aqueous liquid. In fact, the Chen patent does not disclose a cooling compound or a cooling effect in any respect.

With respect to dependent claims 2, 3, 6, 7, 9-16, 18-21, 45, 46, 84, 85, and 88-97, the Examiner states that the "absorbent material and cooling compound may be acidic and basic, respectively" without providing a citation to where this might be found in the Chen patent. As a result, the entire subject matter of these claims is attributed to "discovering the optimum value requir[ing] only a level of ordinary skill in the art." One cannot "optimize" the pH etc. of certain elements (e.g. a cooling compound) if those elements are non-existent in the prior art. In the alternative, claims 2, 3, 6, 7, 9-16, 18-21, 45, 46, 84, 85, and 88-97 are dependent claims that depend from an allowable independent

claim, and are thus allowable themselves for the reasons stated above with respect to independent claims 1, 17, 44, and 83.

Further, and with respect to claims 1-3, 6, 7, 9-21, 44-46, 83-85, and 88-97, the Chen patent does not disclose the subject matter of these claims, and the Examiner cites no secondary art sufficient to solve any of these shortcomings.

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. The Examiner bears the initial burden of establishing the *prima facie* case. See In re Piasecki, 223 U.S.P.Q. 785,787, 745 F.2d 1468, 1471 (Fed. Cir. 1984).

1. The Examiner has not met the burden of establishing prima facie obviousness by failing to identify the motivation in the Chen patent or in what the Examiner describes as general knowledge for modifying the teachings of the Chen patent.

The Chen patent does not disclose the claimed device or method, as described above. The Examiner improperly "picked and chose" the components from one reference and from the Examiner's imagination using the claimed invention as a template in order to form the rejection.

In the Office Action mailed October 5, 2005, the Examiner states that "it would have been obvious to one of ordinary skill [to] modify" the "general conditions being disclosed in the prior art." One cannot "modify," however, that which does not appear in the prior art. The Chen patent does not describe the subject matter of claims 1, 17, 44, or 83, as described above, and the obviousness to modify claimed by the Examiner does not correct this. For example, neither the Chen patent nor the obviousness to modify claimed by the Examiner disclose a cooling compound, so there can be no teaching or suggestion in either concerning how a cooling compound could be included in an absorbent composition, for example, as claimed by the Applicant.

In this Office Action, the Examiner attempts to provide an explanation of the motivation for combining the references. The Examiner's explanation is insufficient. The sole motivation asserted by the Examiner is one of "discovering the optimum value." It is unclear how such goals would motivate one to look to alter the structure disclosed in the Chen patent. There is also no motivation in the Chen patent to look beyond its four corners to gain any benefits. There is, therefore, no motivation within the

patent or what the Examiner describes as general knowledge to apply the teachings of one to the other. The Examiner does not adequately state why one of ordinary skill would read the Chen patent and then look to what the Examiner describes as general knowledge to convert one device to the another device to arrive at the device and method of claims 1, 17, 44, and 83.

Further, the motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. In re Napier, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995). The Examiner has pointed to no disclosure within either the Chen patent or what the Examiner describes as general knowledge that one of skill in the art would look to for such motivation or teaching. Again, the Examiner has not explained why one would look at device identified in the Chen patent and be motivated to change it by applying general knowledge. The Examiner has failed to identify how the cited references suggest the desirability of modifying the device of the Chen patent to include what the Examiner describes as general knowledge. In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992) ("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."). Unless the Examiner provides an adequate explanation of the motivation to combine the cited references, it appears that the Examiner has used the claimed invention as a "template" to pick and choose the components of claims 1, 17, 44, and 83 from the prior art. Id. quoting In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988)[1]. For at least these reasons, Applicants assert that a *prima facie* case of obviousness has not been made and that claims 1, 17, 44, and 83 are patentable over the references.

2. The Examiner has not met the burden of establishing prima facie obviousness by failing to meet the burden of establishing that the prior art reference (or references when combined) teach or suggest all the claim limitations, and by failing to meet the burden of establishing that there would be a reasonable expectation of success associated with modifying the device of the Chen patent to include components from what the Examiner describes as general knowledge.

As discussed above with respect to claims 1, 17, 44, and 83, the Chen patent does not teach or suggest all of the claim limitations. In addition, what the Examiner describes as general knowledge does not correct these deficiencies because it does not teach or suggest the claimed subject matter of

[1] "Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"

claims 1, 17, 44, or 83. There is no teaching or suggestion in the one reference as to why one would use general knowledge of optimizing values to alter the device of the Chen patent and its manufacture to arrive at the subject matter of claims 1, 17, 44, or 83.

In addition to indicating why the cited references provide the requisite motivation and suggestion to be combined, the Examiner should also have indicated why the references provide the required expectation of succeeding in the endeavor. The Examiner has not shown that the references would have suggested to one of ordinary skill in the art that various components from the references should be combined and would have a reasonable likelihood of success. Both the suggestion and the expectation of success must be found in the cited references, not in Applicant's disclosure. In re Dow Chemical, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

In view of the remarks set forth in this section, Applicants respectfully submit that claims 1-3, 6, 7, 9-21, 44-46, 83-85, and 88-97 are in condition for allowance and respectfully request favorable consideration and the timely allowance of those claims.

In conclusion, and in view of the remarks set forth above, Applicants respectfully submit that the application and the claims are in condition for allowance and respectfully request favorable consideration and the timely allowance of claims 1-3, 6, 7, 9-21, 44-46, 83-85, and 88-97. If any additional information is required, the Examiner is invited to contact the undersigned at (920) 721-8863.

The Commissioner is hereby authorized to charge any prosecutorial fees (or credit any overpayment) associated with this communication to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such extension is requested and should also be charged to our Deposit Account.

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The undersigned may be reached at: (920) 721-8863.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I, Mary L. Roberts, hereby certify that on December 22, 2005 this document is being sent by facsimile transmission addressed to the Commissioner for Patents, Alexandria, VA via facsimile number (571) 273-8300.

By: _____
Mary L. Roberts